

Applicant : Avi Moskowitz et al.
Serial No. : 10/721,045
Filed : November 21, 2003
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Attorney's Docket No.: 16157-002001

Amendments to the Drawings:

The attached 10 replacement sheets of formal drawings replace the original sheets for FIGS. 1-10.

Attachments following last page of this Amendment:

Replacement Sheets (10 pages)

REMARKS

As required by the Examiner, applicant submits formal drawings.

Claims 3, 4, 14, 15, 25, 26, 37 and 38 have been rewritten in independent form.

Claims 1, 2, 12, 13, 23, 24, 34 and 36 have been canceled.

In the Office action, the claims were rejected as follows:

(1) Claims 1-2, 5-7, 9-10, 12-13, 23-23, 27-29, 31-32, 34-36, 39-41 and 43-44 were rejected as unpatentable over the information from the Successories.com web site (see attached documents) in view of U.S. Patent No. 7,013,289 (Horn et al.).

(2) Claims 3, 14, 25 and 37 were rejected as unpatentable over the Successories.com material in view of the Horn et al. patent in further view of the published PCT patent application WO 01/86545 ("the PCT document").

(3) Claims 4, 26 and 38 were rejected as unpatentable over the Successories.com material in view of the Horn et al. patent in further view of published US patent application 2003/0055871 (Roses).

(4) Claims 8, 11, 30, 33, 42 and 45 were rejected as unpatentable over the Successories.com material in view of the Horn et al. patent in further view of U.S. Patent No. 6,665,587 (Leone et al.)

(5) Claims 15-18 and 20-21 were rejected as unpatentable over the Successories.com material in view of the Horn et al. patent in further view of the PCT document and the Roses application.

(6) Claims 19 and 22 were rejected as unpatentable over the Successories.com material in view of the Horn et al. patent in further view of the PCT document, the Roses application and Leone et al. patent.

The rejections of the canceled claims are moot.

Claims 3, 14, 25 and 37 are patentable over the cited references

Claim 3 has been rewritten in independent form to include features of claims 1 and 2.

The Successories.com materials disclose a web site from which an item can be ordered. The item (*e.g.*, framed performance award or engraved accessory) can be personalized with text reflecting an award, recognition or performance (*e.g.*, employee of the month).

The Horn et al. patent discloses a global e-commerce system and states that the system can allow manufacturers to provide "customized and personalized service" to customers (col. 15, lines 61-63). At the time of ordering, customers can be given the option to specify attributes for customized manufacturing of some products (col. 15, lines 63-65).

The Office action acknowledges that the Successories.com materials and the Horn et al. patent do not disclose a pre-populated list of one or more achievements attained by the user, any of which the user can select for customizing and personalizing an achievement recognition item. (Office action at page 10, par. 6) However, the Office action alleges that the PCT document discloses a pre-populated list of achievements, any of which can be selected, and that it would have been obvious to combine that feature with the disclosures of the Successories.com materials and the Horn et al. patent to obtain the subject matter of claim 3.

As discussed below, applicant respectfully requests reconsideration.

Claim 3 recites a method that includes providing an on-line, interactive network site including a *personalized network page* from which a user can customize and personalize specifications for a three-dimensional achievement recognition item. The *personalized network page* includes a pre-populated list of one or more achievements attained by the user. The user can select any of the achievements from the pre-populated list for customizing and personalizing the achievement recognition item.

The method includes receiving information through the network site from the user and producing the achievement recognition item in accordance with the user-selected specifications. The information received from the user includes user-selected specifications for customizing and

personalizing features of the achievement recognition item for an achievement selected by the user from the pre-populated list *in the personalized network page*.

Use of such a personalized network page (*e.g.*, a personalized web page through an Internet web site) can increase the likelihood that an individual accessing his or her personalized network page will decide to make a purchase, for example, of a achievement recognition item.

The PCT document discloses a business-to-employee interactive reward and redemption system. Upon confirmation of employee behavior (*e.g.*, high performance), an employee incentives application within the system awards the employee a specified number of points. An email may be sent to the employee with an electronic copy of a recognition certificate. (*See* PCT document at page 17) The PCT document also discloses that the employee's service anniversary can trigger the award of points. Again, the system can send an email to alert the employee of the points awarded and to provide a link to a rewards page. (Page 17) The employee can choose to redeem awarded points in exchange for an item using an on-line page, which allows the employee to choose an item from a catalog. (Page 18) The employee has the option of selecting one of the products listed. Elsewhere (at page 52), the PCT document discloses that the system sends an email message to the employee directing the employee to page within the web site to select a reward (either points or a merchandise reward). If the employee chooses to redeem a merchandise reward, an on-line shopping basket functionality is provided, including the ability for the employee to specify size, color, style and personalization information. (Page 52)

In contrast to the subject matter of claim 3, there is no suggestion in any of the cited references of providing a *personalized network page* that includes a pre-populated list of one or more achievements attained by the user from which the user can select an achievement for customizing and personalizing the achievement recognition item. For example, the PCT document discloses sending an email message that directs the employee to a redemption page; however, the redemption page is not a personalized page. Any employee who wishes to access the redemption page would be directed to the redemption same page(s).

Nevertheless, the Office action points to the Horn et al. patent as disclosing a personalized page. Although that patent does disclose a personalized web page, access to the personalized web page is provided only after a buyer has made a purchase. (Col. 64, line 64 – col. 65, line 9) That is because the purpose of the personalized web page of the Horn et al. patent is to deliver personalized customer service information to the buyer. That is completely different from the personalized page recited in claim 3, which includes a pre-populated list of one or more achievements attained by the user and allows the user to customize and personalize specifications for the recognition item, which only *subsequently* is produced in accordance with the user-specified specifications. Therefore, even if there were some reason to combine the disclosure of the various references, at most that would suggest providing a personalized web page *after* the user has already placed an order for an item. There would have been no suggestion of the subject matter of claim 3.

Independent claims 14, 25 and 37 should be patentable at least for similar reasons.

Claims 4, 15, 26 and 38 are patentable over the cited references

Claim 4 has been rewritten in independent form to include features of claims 1 and 2. Claim 4 now recites a method that includes providing to a user through an on-line interactive network site a sample image of a three-dimensional achievement recognition item. Information is received through the network site from the user. The received information includes user-selected specifications for customizing and personalizing features of the achievement recognition item. The method includes updating the image, in response to receiving user input through the network site, in accordance with the user-selected specifications for customized and personalized features of the achievement recognition item. The method also includes producing the achievement recognition item in accordance with the user-selected specifications.

Updating the image based on the user-selected specifications can allow the user more easily to visualize the three-dimensional achievement recognition item, in accordance with the customized and personalized features, prior to placing an order for the item and before the item

is produced. That can, in some cases, result in increased sales of the achievement recognition items and can help reduce the number of dissatisfied customers.

The Office action acknowledges (at page 20, par. 7) that the Successories.com materials and the Horn et al. patent do not disclose providing a sample image of the achievement recognition item or updating the image, as recited in claim 4. However, the Office action alleges that the Roses patent discloses those features and that it would have been obvious to combine the disclosure of the Roses patent with the Successories.com materials and the Horn et al. patent to obtain the subject matter of claim 4.

Applicant respectfully requests reconsideration.

As discussed above, the Successories.com materials disclose a web site from which an item can be ordered. The item (*e.g.*, framed performance award or engraved accessory) can be personalized with text reflecting an award, recognition or performance (*e.g.*, employee of the month).

The Roses patent discloses an Internet printing system (par. [0001]) and, in particular, a method for generating a two-dimensional document using a web site from which a user can select a template that includes a predefined format for the document (pars. [0033] – [0034]). A preview of the template is displayed in a web page (par. [0034]). The user can select and edit images to be incorporated into the selected template (par. [0043]). By pressing a button on the web page, the user can view a preview of the document with the edited images (par. [0043]).

Displaying a preview of a two-dimensional document based on text and images is very different from updating an image of the type of items disclosed in the Successories.com materials (*e.g.*, framed performance awards, award clocks, and medallion awards) and the three-dimensional item as recited in claim 4. A person of ordinary skill would not have been motivated to use the techniques disclosed in the Roses patent together with the disclosures of the Successories.com materials and the Horn et al. patent.

That distinction is emphasized further in some of the dependent claims. For example, claim 6 recites that the achievement recognition item comprises a document *mounted on or embedded in a substrate*, and claim 7 recites that the user-selected specifications include a *substrate material*. Likewise, claim 10 recites that the achievement recognition item comprises an engraved plate mounted on a substrate, and the user-selected specifications include text to be engraved on the plate.

Previewing a two-dimensional document and printing such a document are completely different from updating an image of a three-dimensional item and producing the item as recited in the pending claims.

Independent claims 15, 26 and 38 should be patentable at least for similar reasons.

The dependent claims are patentable over the cited references

None of the other cited references discloses or suggests the features missing from the Successories.com materials, the Horn et al. patent, the PCT document and the Roses patent.

Therefore, the dependent claims should be patentable at least for the reasons applicable to the respective claims from which they depend.

Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

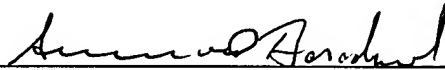
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Enclosed is a \$910.00 check for excess claim fees and for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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